

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

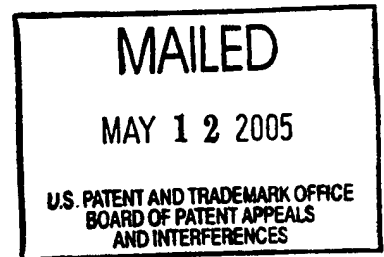
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte NANCY A. ABBE

Appeal No. 2005-0997
Application No. 09/844,627

HEARD: May 4, 2005



Before FRANKFORT, MCQUADE, and NASE, Administrative Patent Judges.
MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Nancy A. Abbe appeals from the final rejection of claims 1 through 9, 13 through 17, 19, 20, 24 and 26, all of the claims pending in the application.

THE INVENTION

The invention relates to "food containers for storing food in the freezer and refrigerator and for identifying the contents of the container" (specification, page 1). Representative claims 1 and 26 read as follows:

1. A food storage unit, comprising:
a container comprising a container top, a container bottom, an inner wall and an outer wall having a fixed geometric relationship, said inner and outer walls forming a channel there between, said channel including a label container area that is accessible by a user for the insertion of a label therein, at least a portion of said outer wall being translucent such that a

label placed in said label container area may be read without being removed from said food storage unit;

at least one label support member that is located within said channel and is physically attached to said inner and outer walls, said label support member that prevents a label inserted into said label container area from falling to the bottom of said channel; and

a lid that may be fixably attached to said container top to seal said container CLOSED.

26. A food storage unit, comprising:

a container comprising a container top, a container bottom, an inner wall and an outer wall having a fixed geometric relationship, said inner and outer walls forming a channel there between, said channel including a label container area that is in close proximity to said container top, said label container area that is accessible by a user for the insertion of a label therein, at least a portion of said outer wall being translucent such that a label placed in said label container area may be read without being removed from said food storage unit; and

a lid that may be fixably attached to said container top to seal said container CLOSED.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Wooster	242,805	Jun. 14, 1881
Pichereau	417,082	Dec. 10, 1889
Barhite	746,264	Dec. 08, 1903
Oxley	1,147,041	Jul. 20, 1915
Morris (Morris '151)	4,432,151	Feb. 21, 1984
Morris (Morris '059)	4,505,059	Mar. 19, 1985
Hepburn	4,927,041	May 22, 1990
Dorney	6,062,380	May 16, 2000
Greiner	6,253,918	Jul. 03, 2001

THE REJECTIONS

Claims 1 through 9, 13 through 17, 19, 20, 24 and 26 stand rejected under 35 U.S.C. § 112, first paragraph, as being based on a specification which is non-enabling.

Claims 1 through 6, 9, 13, 15, 19, 20 and 24 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Oxley.

Claims 1 through 6, 9, 13, 15, 20, 24 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by either Morris '059 or Morris '151.

Claims 1, 3, 5, 9, 15, 19, 24 and 26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Pichereau.

Claims 1 through 6, 9, 13 through 17, 19, 20, 24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Barhite in view of Dorney and Greiner.

Claims 1 through 6, 9, 13, 15, 20, 24 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wooster in view of Dorney and Greiner.

Claims 1 through 6, 9, 13, 15, 19, 20 and 24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Oxley in view of Wooster.

Claims 7, 8 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Wooster in view of Dorney, Greiner and Hepburn.

Claims 7, 8 and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morris '059 or Morris '151 in view of Hepburn.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Oxley in view of Wooster.

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Morris '059 or Morris '151 in view of Barhite.

Attention is directed to the main and reply briefs (filed February 18, 2004 and June 29, 2004) and the final rejection and answer (mailed June 5, 2003 and April 29, 2004) for the respective positions of the appellant and the examiner regarding the merits of these rejections.

DISCUSSION

I. The 35 U.S.C. § 112, first paragraph, rejection

The dispositive issue with regard to the enablement requirement of § 112, ¶ 1, is whether the appellant's disclosure,

considering the level of ordinary skill in the art as of the date of the application, would have enabled a person of such skill to make and use the claimed invention without undue experimentation.

In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563-64 (CCPA 1982). In calling the enablement of the disclosure into question, the examiner has the initial burden of advancing acceptable reasoning inconsistent with enablement. Id.

The examiner, making reference to the two independent claims on appeal, considers the appellant's disclosure to be non-enabling because

Claim 1 states that a portion of the outer wall is translucent in line 8. Translucent is defined as transmitting light but causing sufficient diffusion to prevent perception of distinct images. In lines 8 and 9 of claim 1, it is stated that a label placed in the label area may be read (through the outer wall). This doesn't seem possible since the translucence of the outer wall would distort the image to prevent perception. Claim 26 has similar claim language [final rejection, page 2].

The appellant's specification (see page 8) indicates that at least the portion the outer wall of the container that includes the label area may be fabricated of a "translucent" material so that users can easily read the writing on the label. The examiner has advanced a particular definition of the term

"translucent" which arguably conflicts with this intention. As persuasively pointed out by the appellant, however, "translucent" has other conventionally accepted definitions, e.g., "clear, lucid" and "clear, transparent" (see page 9 in the main brief), which are entirely consistent with the appellant's use of the term. Given this more reasonable understanding of the term "translucent," the examiner's position that the appellant's disclosure, considering the level of ordinary skill in the art as of the date of the application, would not have enabled a person of such skill to make and use the subject matter recited in the appealed claims without undue experimentation is not well taken.

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, first paragraph, rejection of independent claims 1 and 26 and dependent claims 2 through 9, 13 through 17, 19, 20 and 24.

II. The 35 U.S.C. § 102(b) anticipation rejections

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. RCA Corp. v. Applied Digital Data Sys., Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984). In other words, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field

of the invention. Scripps Clinic & Research Found. v. Genentech Inc., 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

Oxley discloses a display box for biscuits, crackers, cookies, cakes and other such bakery products. The box D includes a hinged cover, a glass window E on one of its sidewalls, a pocket shelf structure A, B within the box and adjacent the window for receiving and maintaining selected ones of the bakery products in an upright display position, and a backing partition F disposed behind pocket shelf structure to secure it in place adjacent the window.

To the extent that Oxley's backing partition F, glass window E and shelf structure A constitute an inner wall, an outer wall and a label support member, respectively, as found by the examiner (see pages 2 and 3 in the final rejection), shelf structure A is not "physically attached" to the backing partition F and glass window E as required by claim 1 under any reasonable interpretation of these words. Also, Oxley does not provide any factual support for a determination that the hinged cover disclosed therein embodies a lid that seals the container closed as recited in the claim. Hence, the examiner's determination that Oxley is anticipatory with respect to the subject matter recited in claim 1 is unsound.

Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claim 1, and dependent claims 2 through 6, 9, 13, 15, 19, 20 and 24, as being anticipated by Oxley.

Morris '059 and Morris '151 disclose advertising devices comprising tower-like structures 20 for displaying advertisements such as business cards 24. Each structure includes a transparent upright rectangular tube 12, a top cover 26, a bottom cover 34, and four support members 38 biased against the inside surfaces of the rectangular tube and bearing ridges (45 in Morris '059 and 46 in Morris '151) for supporting a business card or the like between the associated support member and tube wall.

To the extent that the Morris support members 38, tube 12 and ridges (45 in Morris '059 and 46 in Morris '151) constitute an inner wall, an outer wall and a label support member, respectively, as found by the examiner (see pages 6 and 7 in the answer), the ridges are not "physically attached" to the tube 12 as required by claim 1 under any reasonable interpretation of these words. Also, neither Morris reference provides factual support for a determination that the "containers" respectively disclosed thereby include lids that seal the containers closed as

recited in claims 1 and 26. Thus, the examiner's determination that both Morris '059 and Morris '151 are anticipatory with respect to the subject matter recited in claims 1 and 26 is unsound.

Hence, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 1 and 26, and dependent claims 2 through 6, 9, 13, 15, 20 and 24, as being anticipated by either Morris '059 or Morris '151.

Pichereau discloses a two-piece glass inkstand comprising a bottom portion (Figure 1) and a cover portion (Figure 2). The bottom portion includes a central cup a and three ink troughs d arranged about the central cup and defined by inner and outer annular walls, radial partitions e and inclined bottoms c. The cover portion includes a central sponge-cup g, j, a peripheral rim i, and a dipping hole slot f in the peripheral rim. In use,

the lower part j of the sponge-cup will fit into cup a, and so that that part of the cover i i i will fit close down on the upper part of cup a, partitions e e e, and ink-troughs d d d of Fig. 1. Having so placed the combination-cover, it will easily be discovered that the lower part j of sponge-cup g, Fig. 2, fits like an axle in cup a, Fig. 1, and consequently that slot f, Fig. 2, can be moved about over the tops of these circular ink-troughs d d d, Fig. 1, with great ease [page 2, lines 36 through 46].

To the extent that the inner annular wall, the outer annular wall and the inclined bottoms of Pichereau's bottom portion (Figure 1) constitute an inner wall, an outer wall and a label support member, respectively, as implicitly found by the examiner (see page 7 in the answer), Pichereau does not provide any factual support for the proposition that the cover portion (Figure 2) embodies a lid that may be fixably attached to the container top to seal the container closed as recited in claims 1 and 26. Consequently, the examiner's determination that Pichereau is anticipatory with respect to the subject matter recited in claims 1 and 26 is unsound.

Therefore, we shall not sustain the standing 35 U.S.C. § 102(b) rejection of independent claims 1 and 26, and dependent claims 3, 5, 9, 15, 19 and 24, as being anticipated by Pichereau.

III. The 35 U.S.C. § 103(a) obviousness rejections

For the reasons discussed above, the bakery product display box disclosed by Oxley and the business card advertising devices disclosed by Morris '059 and Morris '151 fail to meet one or more of the limitations set forth in independent claims 1 and/or 26. As conceded by the examiner (see pages 3 through 6 in the final rejection), the cream separator disclosed by Barhite and the milk

cooler disclosed by Wooster also fail to meet one or more of the limitations in these claims. Suffice to say that the only suggestion for combining such disparate devices with one another and/or with the glow cup disclosed by Dorney, the decorative container disclosed by Greiner and/or the floating cooler disclosed by Hepburn stems from hindsight knowledge impermissibly derived from the appellant's disclosure. Consequently, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1 through 6, 9, 13 through 17, 19, 20, 24 and 26 as being unpatentable over Barhite in view of Dorney and Greiner, the standing 35 U.S.C. § 103(a) rejection of claims 1 through 6, 9, 13, 15, 20, 24 and 26 as being unpatentable over Wooster in view of Dorney and Greiner, the standing 35 U.S.C. § 103(a) rejection of claims 1 through 6, 9, 13, 15, 19, 20 and 24 as being unpatentable over Oxley in view of Wooster, the standing 35 U.S.C. § 103(a) rejection of claims 7, 8 and 14 as being unpatentable over Wooster in view of Dorney, Greiner and Hepburn, the standing 35 U.S.C. § 103(a) rejection of claims 7, 8 and 14 as being unpatentable over Morris '059 or Morris '151 in view of Hepburn, the standing 35 U.S.C. § 103(a) rejection of claim 14 as being unpatentable over Oxley in view of Wooster, or the standing

35 U.S.C. § 103(a) rejection of claims 16 and 17 as being unpatentable over Morris '059 or Morris '151 in view of Barhite.

SUMMARY

The decision of the examiner to reject claims 1 through 9, 13 through 17, 19, 20, 24 and 26 is reversed.


REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge

John P. McQuade
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JOHN P. MCQUADE
Administrative Patent Judge


JEFFREY V. NASE

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